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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,730	03/21/2001	Wolfgang Fraas	P01,0043	7515

21171 7590 06/14/2005

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EXAMINER
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JUNTIMA, NITTAYA

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/787,730

Applicant(s)

FRAAS ET AL.

Examiner

Nittaya Juntima

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☒ Claim(s) 17-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the amendment filed on 2/8/2005.
2. The objections to the oath/declaration, drawings, and claims, and the rejection under 35 U.S.C. 112, second paragraph are withdrawn in view of applicant's amendment.
3. Claims 1-13 were cancelled as per the Preliminary Amendment filed on 3/21/2001.
4. Claims 14 and 15 stand rejected under 35 U.S.C 102(e).
5. Claims 16 remains rejected under 35 U.S.C 103(a).
6. Claims 17-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 14 and 15** are rejected under 35 U.S.C. 102(e) as being anticipated by Pierson, Jr. (USPN 6,272,128 B1).

Per claim 14, as shown in Fig. 1, Pierson, Jr. teaches a method for identifying a hub

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(ATM switch 109) in a communication network (network shown in Fig. 1) having a plurality of hubs (not further defined, read on ATM switch 109 and ATM switch 115 which must also connect to its own users similar to ATM switch 109) connecting communication terminals (users 145A-145V and inherent users of ATM switch 115) to switches (not further defined, read on ATM switches 106 and 120) in a switching system (not further defined, therefore, ATM switches 106 and 120 are collectively a switching system) and using a time-slot-oriented data format (T1 frame in Fig. 2) formed from a periodic sequence of channel-oriented information segments (T1 frame bit 205 and T1 payload 210 in Fig. 2) for data transmission between the communication terminals via the hubs and the switching system (user data over T1 frames are packed into ATM cells and transmitted over network 101 to the respective destination ATM switch and converted back to T1 frames and transmitted to the destination users, col. 7, ll 35-52 and Fig. 6), said method comprising:

Associating each of the hubs (each of the ATM switches 109 and 115 in Fig. 1) with an unambiguous address (VPI value in a VPI field 420 of Fig. 4 of an ATM cell transmitted from ATM switch 109 to ATM switch 106 shown in Fig. 1 during data communication between users 140A and 145A, different VPI value also applies to ATM cell originated from ATM switch 115) not assigned to a switch in the switching system (not defined, therefore, ATM switches 106 and 120 are collectively a switching system). See col. 8, ll 2-18 and 55-67.

Transmitting the address of a hub (VPI value in an ATM cell transmitted by ATM switch 109) via the communication network (network shown in Fig. 1) to the switching system (ATM switch 106 is part of the switching system having switches 106 and 120) in an agreed information segment (a VPI field 420 shown in Fig. 4) upon request (an inherent call setup

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request). An inherent call setup request must be originated by a user who wants to send the data, e.g. user 140A in Fig. 1, in order to start a data communication between any two users, and once the connection is set up, an ATM cell carrying VPI value, e.g. from ATM switch 109 to ATM switch 106, would be transmitted over the network. See col. 7, ll 35-52, col. 8, ll 2-18 and 55-67.

Per claim 15, Pierson, Jr. teaches that the request (the inherent call set up request requesting for data communication made from user 140A to 145A as explained in the rejection of claim 14) is made during a message transmission (an inherent call set up transmitted from user 140A to user 145A) from the switching system (ATM switch 106 in Fig. 1 is part of the switching system having switches 106 and 120) to the communication terminal (145A). An inherent call setup request originated by user 140A must be sent as a call set up message from ATM switch 106 to user 145A via ATM switch 106 in order for the connection between the two users to be set up over ATM network 101. See col. 7, ll 35-52, col. 8, ll 2-18 and 55-67.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson, Jr. (USPN 6,272,128 B1).

Per claim 16, Pierson, Jr. fails to explicitly teach that the request is made during a message transmission from the communication terminal to the switching system.

However, as seen on Fig. 1 that user 140A is connected to ATM switch 106, and user 145A is connected to ATM switch 109. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to include in the teaching of Pierson, Jr. that the request is made during a message transmission from the communication terminal, e.g. user 145A in Fig. 1, to the switching system, e.g. ATM switch 106. The motivation/suggestion would have been to enable the communication terminal (user 145A in Fig. 1) to initiate the data communication, thereby providing an equal opportunity for any user connected to either the hub (ATM switch 109 in Fig. 1) or the switching system (ATM switch 106) to initiate such communication.

### *Response to Arguments*

11. Applicant's arguments filed 2/8/2005 have been fully considered but they are not persuasive.

A. In the remarks regarding independent 14, the applicant argued that the DTE, not the ATM switches, in Fig. 1 of Pierson, Jr. most closely correspond to the "hubs connecting communication terminals...using a time-slot-oriented data format" as recited in claim 14, ll 2-5.

In response, as shown in Fig. 1, Pierson, Jr. clearly teaches ATM switch 109 and ATM switch 115 (which must also connect to its own users similar to ATM switch 109) connecting to end users 145A-145V and inherent end users of ATM switch 115 to a switching system, e.g. ATM switches 106 and 120, and using T1 frames which are encapsulated in ATM cells (see

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Figs. 2 and 6) for data transmission between end users via the ATM switches 109 and 115 and the switching system, i.e. ATM switches 106 and 120, col. 7, ll 35-52. Therefore, there is no structural or functional difference between the hubs recited in the preamble and the ATM switches 109 and 115 of Pierson, Jr. The recited hubs clearly read on the ATM switches 109 and 115 of Pierson, Jr. Further, the applicant failed to point out an error in the interpretation of the method steps. Therefore, the rejection is maintained.

B. Due of the time constraint, examiner is unable to contact the attorney of record to discuss the amendment. However, prior to filing an official reply to this Office action, the attorney is welcome to fax a proposed amendment directly to the examiner at 571-273-3120 for review and discussion on any possible further amendments in order to overcome the rejection.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Li et al. (ISPN 6,195,714 B1), disclosing hub address (address of the TDM device) in ATM cell for communication of TDM data between end users (Fig. 1a and col. 6, ll 6-col. 8, ll 60).

- Hiekali (USPN 5, 619, 500), disclosing ATM hub (ATM gateway) for carrying TDM data between end users through ATM network (Figs. 3 and 9).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

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Figs. 2 and 6) for data transmission between end users via the ATM switches 109 and 115 and the switching system, i.e. ATM switches 106 and 120, col. 7, ll 35-52. Therefore, there is no structural or functional difference between the hubs recited in the preamble and the ATM switches 109 and 115 of Pierson, Jr. The recited hubs clearly read on the ATM switches 109 and 115 of Pierson, Jr. Further, the applicant failed to point out an error in the interpretation of the method steps. Therefore, the rejection is maintained.

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- Hiekali (USPN 5, 619, 500), disclosing ATM hub (ATM gateway) for carrying TDM data between end users through ATM network (Figs. 3 and 9).

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima  
6/10/05

  
RICKY NGO  
PRIMARY EXAMINER  
8/12/05